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Chuck Marmor
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Thank you very much for taking the time to talk with me on the phone yesterday. I was impressed and delighted that you let me tell you pretty much all about the frustration and concerns I have with my current dealings with the USPTO, and in particular with Mr. Lacyk re my application number 10/509,968.

As I told you, my basic problem is that I feel that for some reason—perhaps I had somehow unintentionally annoyed or offended him—my invention never got a fair hearing. And now I am about to lose five years and (for me) a lot of money that I have spent on trying to get my points of view considered, now that I have received Mr. Lacyk's most recent FINAL office action on this case. So, what I want from you is a review of the case from, I hope, a less biased perspective.

I want in this letter to go over the things we discussed in our phone call yesterday, and to supply a few bits of other information I may have neglected to tell you then. I know that I was speaking rather rapidly and you may not have had time to take as many notes as you would like to have at hand when you go over my case's file.

First I should note that this case is the national stage of the PCT (international) application I filed in connection with my previous patent number US 6,832,983 B2. That patent application was filed on April 1, 2002, assigned the number 10/113,522, and issued on Dec 21, 2004. I filed my follow-on PCT application on 28 March 2003.

I requested a Preliminary International Examination specifying the USPTO as the IPEA. On 20 August 2003 the PCT Preliminary Search Report was issued. (My copy of that report was a photocopy from the office of Ladas & Parry, the attorneys I used to help me in the initial steps of the PCT filing, and it was cut off so that I do not have the name of the person who performed that search.)

Sometime in mid-October 2003 I got a call from John Lacyk. In it he told me that he planned to deny my basic claim (Claim #1) in my application 10/113,522, as he felt that Jansen had anticipated it by his patent application. And then he virtually insisted that I partition my case, and in the process drop any and all claims relating to securing a headdress or other garment by "snapping" them into the wearer's ear canals. Seeing no alternative, I accepted his suggestion (which felt to me at the time more like a demand).

Then, after several office actions and responses to them—during which I felt an increasing sense of anger on Mr. Lacyk's part—and after I had reduced my case to just those claims he said he would approve, he did allow the now-substantially reduced scope patent to proceed to issuance.

In the meantime I had also pursued the PCT application. But, as I told you in our phone conversation (and I do understand that this whole fiasco was none of your responsibility), I got stalled at the gate when I went to enter the PCT application into the US national phase. The problem was that I was unsure what the proper fee would be. So I called for help, and when I got it, I was told one figure—which I used on the credit card form—and only after a six-month delay learned that it had been deemed insufficient, and that therefore my application was considered "abandoned." [Curiously, when I asked what the right fee would have been I got at least four different numbers, each from some USPTO employee who felt he knew the right answer. One of those was the amount I had paid. The others were higher because of a fee increase that went into effect on the day I filed, and then yet another increase that went into effect months later, but before I learned of my supposed abandonment of my application.]

After much additional effort (and the payment of a lot more money—including a \$750 revival application fee in addition to the difference between what I originally paid and what it would have cost had I submitted the application at the time of the revival, many months after I originally tried to file it) I got it revived. And I was assured that, since I was now over 65 years old, the case would be put on a fast track. That episode began in October of 2004 and the case didn't get revived until April of 2006, about a year and one-half after it started. But, worse, the case didn't move back into your hands, it now appears, until March of 2007. [What it was doing stuck in the OIPE for all that time is a total mystery to me!]

Somewhere along the way, as I recall (but I cannot now put my fingers on any written record of this), Mr. Lacyk commented to me about the PCT application that he thought many of my original claims for it would also be rejected, but he thought that just certain ones were "novel and useful." (I think this conversation took place before I attempted to file the US national stage of the PCT application—perhaps shortly after the Preliminary Search Report on that PCT application.) I took that remark to mean that if only I reduced the PCT case to just those items he would surely swiftly approve it all and let it pass to issuance. And so, when it came time to enter the national stage in the US, that is what I tried to do.

Thus, starting about fourteen months ago the US national stage application of my PCT case was back in Mr. Lacyk's hands—or so I surmise from the record I accessed on PAIR. Five months later I got notice of a Non-final rejection of all of my claims. Naturally, I was both startled and very disappointed at that turn of events. Among other things that Mr. Lacyk said in the action was while it appeared that I had cancelled all but a few of my original claims (which is what I had intended to do, as I commented above), in fact I had done so in not quite the right format, which he referred to as an informality that needed to be corrected.

I consulted at that point with my friend, who is a semi-retired patent attorney with many years of experience—primarily at Bell Labs where he tells me he worked on a nearly daily

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basis with William Shockley and others of their scientists. It was he who helped me with my first patent application some years prior to this case, which resulted in my receiving US patent number 5,959,702. And it was he who helped me write the claims portion of my application number 10/113,522, which eventually resulted in my receiving patent US 6,832,983 B2. So at this point I valued his comments on what I had done and what Mr. Lacyk's responses had been.

My friend said, after looking over my submissions in response to office actions in the earlier US patent application that I "must have driven the examiner to distraction" by the way I phrased things. [Hence my suggestion that perhaps I unintentionally annoyed or offended Mr. Lacyk.] He hoped to help me draft a much simpler and more direct statement of the case—which he considered a strong one—for the original set of claims I had made, including my fundamental assertion that Jansen had by no means anticipated my invention.

Specifically, he noted that Jansen says in his first claim that he started with a "groin-engaging" frame to which he added an insert. In the specifications it becomes clear that this insert is only needed to insure that the garment doesn't shift off of the critical areas of the body—and it is not meant to hold the garment to the body. He does at one point mention that the insert does somewhat (he uses the term "substantially") secure the garment so the clamping action of the frame may not be necessary. But he never actually proposes eliminating the frame's "groin-engaging" character.

My invention (while it started without my having any knowledge of the Jansen patent) can be explained as taking Jansen's idea and removing the requirement for a groin-engaging frame altogether, plus generalizing it by saying the insert (or inserts) can go into any bodily orifice. I believe that simplifying and generalizing a previously proposed idea are recognized, almost iconic, ways of coming up with a patentable new idea.

And, while Jensen suggest that his insert might provide a means of "substantially" securing the garment in place (he doesn't seem to think it would really do the whole job), his proposed design would not actually do even that. Specifically, it is so narrow and such widening as it has is so gradual, that any force on the insert of the sort that can easily be anticipated in the actual wearing of a garment would quickly pull the insert all or most of the way out of the anus—which would defeat its purpose of insuring the modesty-required very close coverage of the area around that bodily orifice. And with a vaginal insert of a similar design this would happen even more easily.

What is needed, as my application clearly states, is something that deforms on insertion and recovers its original shape—or something that forces the body to substantially deform upon its insertion with the body being thereafter allowed to resume approximately its original shape. This is exactly what a snap does—and it is what my insert must do in order to retain the garment closely adjacent to the wearer's body despite the tugs and pulls that are almost certainly going to happen as the wearer moves about. And the design I propose is one that meets this requirement, quite unlike Jansen's design.

It may be appropriate for me here to note that I am a physicist by training and have an earned Ph.D. in the subject. And when I applied for my first patent (on a lensless projector), the examiner found several prior patents that seemed to suggest my ideas weren't original.

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Key to my surmounting those objections was that I pointed out that the most relevant of those prior patents was for an idea that actually could not work. It was simply contrary to the laws of physics. My feeling is that this case has some salient points of comparison with that case inasmuch as I believe Jansen's assertions about his insert's capability of securing a garment on its own is simply not true.

Further, I assert, that the addition of a hygienic covering, or the use of other bodily orifices are not all that "obvious to one skilled in the art." Certainly so far as I know no one else has advanced this idea in the now over a decade since Jansen applied for his patent.

So, with my friend's help, I redid all the claims and reasserted them, and explained my reasons for believing that they were valid and should all be allowed. This is what I sent in as my response to Mr. Lacyk's office action (the non-final rejection). Mr. Lacyk's response to what I wrote is, as I read it, an indigent one—almost outraged that I should have the temerity to suggest that he might be mistaken. He further goes on to complain that since I got the first patent that he had allowed, and on which my PCT application was based (but which, I note, was NOT directly on my original inventive idea, but merely on some of my elaborations of it, since Mr. Lacyk did not allow me my original claim #1 nor many others of my original claims) he felt that I should not expect to get what he termed another patent on this idea.

I do understand that I should only expect to get one patent on my invention. But since I didn't get it in the first go around, I would like to see if I can get patent protection on it now.

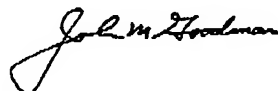
Again, I want to thank you very much for taking the time to understand what I am claiming and to see if you think perhaps it could be allowable as a patent at this point in the process.

I will be traveling for the next week, but if you wish to discuss this with me I would more than welcome a phone call from you any time during the week of August 4th through August 8th. You can reach me most easily at 714-537-6400, or if I don't answer that number, you may try my cell phone at 714-335-7555. (Note: I typically answer the phone even if I am asleep—I do wake up quite quickly in those circumstances—and so to insure that I haven't gone out for the day, you might try me right after you get into the office in the morning when it is well before most people's day here on the west coast. Or you can wait and call later in the day if you prefer to do that.)

In any event, I look forward to hearing from you once you have had time to study my case in the necessary detail.

Thank you.

Sincerely yours,



John M. Goodman